

REMARKS

Claims 1 and 9-14 are currently pending. Claims 3 and 15 have been canceled and claims 1 and 14 have been amended. No new matter has been added. Applicant thanks the Examiner for the indication of allowable subject matter in claim 15. Applicant respectfully requests reconsideration of this application in light of the above amendment and the following remarks.

Claim 1 has been amended to incorporate the subject matter of claim 15, which the Examiner indicated as being allowable. Claim 1 has also been amended to incorporate the subject matter of intervening claim 3. Support for this amendment is found throughout the Specification, as filed. Claim 15 has been canceled. Support for this amendment is found throughout the Specification, and drawings, as filed, for example in Figures 1-3.

Claim Objections

1. Claim 15 has been objected to for being dependent upon a rejected base claim, but was indicated to be allowable if rewritten in independent form. Claim 1 has been amended to incorporate the subject matter of claims 3 and 15. Accordingly, Applicant respectfully submits that claim 1, as currently presented, is patentable. The objection to claim 15 has been rendered moot in view of its cancellation.

Claim Rejections Under 35 U.S.C. § 112

2. Claim 13 has been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicant respectfully traverses this rejection.

The Office Action states, “[c]laim 13 recites ‘an injection mechanism’ which appears to be a double inclusion of the ‘first cylindrical member’ and/or ‘needle valve’ recited in claim 1,” and that “[c]laim 13 recited ‘a pressure increasing mechanism’ which appears to be a double inclusion of ‘the fourth cylindrical member’ and/or ‘plunger’ recited in claim 1.” See Final Office Action at page 2.

Applicant respectfully submits that an injection mechanism and pressure increasing mechanism could be arranged in a manner different from that claimed in claim 13, while still meeting the limitations of claim 1, and as such, claim 13 is simply further defining one embodiment.

For example, in some fuel injectors, there is no pressure increasing mechanism within the fuel injector. Instead, pressurized fuel is delivered to the fuel injector and requires no increase in pressure prior to injection. See Substitute Specification at page 1, paragraph 2. In the case where fuel is delivered already pressurized, the claimed fourth cylindrical member would not be part of a pressure increasing mechanism. Naturally, other alternative arrangements for the internal components of a fuel injector would be possible.

Applicant respectfully submits that while the first cylindrical member and needle valve may be part of an injection mechanism, and the fourth cylindrical member and plunger may be part of a pressure increasing mechanism, this recitation in claim 13 does not constitute a “double-inclusion,” but rather is merely further defining the function of the elements in one embodiment, since these elements need not necessarily have the functions recited in claim 13.

For at least the above reasons, Applicant respectfully submits that claim 13, as currently presented, satisfies the requirements of 35 U.S.C. § 112, second paragraph for

definiteness. Withdrawal of the rejection applied to claim 13 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claim Rejections Under 35 U.S.C. § 102

3. Claims 1, 9, 11 and 13 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,007,000 to DeLuca (“DeLuca”). Applicant respectfully traverses this rejection.

DeLuca cannot anticipate independent claim 1, because it does not teach every element of this claim. See MPEP §2131, p. 2100-69 (*quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) (“[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”)).

Claim 1, as amended, recites the allowable subject matter of claim 15. For at least this reason, amended independent claim 1 defines patentable subject matter over DeLuca. Claims 9, 11 and 13 depend from claim 1, and therefore also define patentable subject matter over DeLuca. Withdrawal of the rejection applied to claims 1, 9, 11 and 13 under 35 U.S.C. § 102(b) as being anticipated by DeLuca is respectfully requested.

4. Claims 1 and 12 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,371,382 to Niethammer et al. (“Niethammer”). Applicant respectfully traverses this rejection.

Niethammer cannot anticipate claims 1 and 12 because it does not teach or suggest each and every element of these claims. See MPEP §2131, p. 2100-69.

As set forth above, amended Claim 1 recites the allowable subject matter of claim 15. For at least this reason, amended independent claim 1, and claim 12, which depends from claim 1, define patentable subject matter over Niethammer. Withdrawal of the rejection applied to claims 1 and 12 under 35 U.S.C. § 102(e) as being anticipated by Niethammer is respectfully requested.

5. Claims 1, 3 and 14 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,632,444 to Camplin et al. ("Camplin"). Applicant respectfully traverses this rejection. Claim 3 has been canceled.

Camplin cannot anticipate claims 1 and 14 because it does not teach or suggest each and every element of these claims. See MPEP §2131, p. 2100-69.

As set forth above, amended Claim 1 recites the allowable subject matter of claim 15. For at least this reason, amended independent claim 1 and claim 14 which depends from claim 1, define patentable subject matter over Camplin. Withdrawal of the rejection applied to claims 1 and 14 under 35 U.S.C. § 102(b) as being anticipated by Camplin is respectfully requested. The rejection of claim 3 has been rendered moot in view of its cancellation.

Claim Rejections Under 35 U.S.C. § 103

6. Claims 10 has been rejected under 35 U.S.C § 103(a) as being unpatentable over DeLuca. Applicant respectfully traverses this rejection.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03 (citing In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

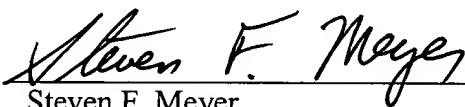
Claim 10 depends from independent claim 1 and therefore incorporates the subject matter of this claim. Since, for the above reasons, claim 1 is allowable over DeLuca, so too is claim 10. Withdrawal of the rejection applied claim 10 under 35 U.S.C § 103(a), as being unpatentable over DeLuca, is respectfully requested.

CONCLUSION

In light of the foregoing, Applicant respectfully submits that all claims, as currently presented, are patentable and that this application is in condition for allowance.

Respectfully submitted,
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